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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 17.10.2023

CORAM

THE HON'BLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM).No.134 of 2023

(OA/10/2019/TM/CHN)

PACIFIC POWER SOURCE, INC.
A corporation organized and existing under the laws of
the State of Delaware, USA,
17692 Fitch,
Irvine, CA 926146022
USA. ... Appellant

Versus

The Registrar of Trade Marks
Trade Marks Registry,
Chennai. ... Respondent

PRAYER: This Civil Miscellaneous Appeal filed under Section 91 of the Trade Marks Act, 1999 in respect of goods or services falling in one class, praying to allow the appeal and set aside the order dated 06.08.2018 passed by the respondent refusing the mark PACIFIC POWER SOURCE and device vide Application No.2252553 in class 9 and to allow the device to proceed to registration.

For Appellant : Mr. Dwarakesh Prabhakaran

For Respondent : Mr. A.R. Sakthivel,
Senior Panel Counsel.

JUDGMENT

The appellant challenges the grounds of decision dated 06.08.2018 pursuant to the order of refusal dated 09.03.2017.

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2. The appellant applied for registration of the following device mark:



on 19.12.2011, on a "proposed to be used" basis. The application is in respect of linear and non-linear solid state AC electric power sources, comprised of one or more switches, amplifiers and/or controllers; electric power converters; and frequency converters to change the frequency of electric power supplied to electrical appliances and electric machines.

3. By examination report dated 13.03.2013, the Registrar of Trade Marks raised objection under Section 11 of the Trade Marks Act, 1999 (Trade Marks Act) by citing multiple marks. By reply dated 10.03.2016, the appellant asserted that its application was in respect of a composite mark and such mark should not be dissected into its elements. Upon consideration as a whole, the appellant stated that its mark is distinctive and distinguishable from the cited marks. After a hearing on 07.03.2017, by order dated 09.03.2017, the application was rejected by referring to Sections 9 & 11 of the Trade Marks Act. Thereafter, the grounds of decision was issued on 06.08.2018. The Registrar of Trade Marks stated that the

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prominent part of the applicant's mark is deceptively similar to the cited marks and the said marks are prior to the applicant's mark. It was also stated that the mark has not acquired any distinctive character. The present appeal was filed in these facts and circumstances.

4.Learned counsel for the appellant referred to the application for registration and the examination report. By inviting my attention to the search report annexed to the examination report, learned counsel placed for consideration the additional typed set of documents containing documents relating to the current status of registration of the cited marks.

5.Out of the cited marks, learned counsel for the appellant stated that only the word mark “PACIFIC CENTURY CYBERWORKS”, which is registered under Trade Mark No.951770, and the label mark “PACIFIC”, which is registered under Trade Mark No.2074774, are currently valid.

6.As regards both these marks, learned counsel contended that the appellant's mark, when viewed as a whole, is distinctive and distinguishable from the cited marks. By referring to the grounds of decision, learned counsel asserted that the Registrar of Trade Marks rejected the application

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by construing the word "PACIFIC" as the prominent feature of the appellant's mark. He pointed out that this approach is erroneous and the marks should have been compared as a whole. He further submitted that the search report is dated 28.01.2013 and that several marks cited therein were not renewed up to 28.01.2013. Even otherwise, learned counsel submitted that the current status of registration of these cited marks is a relevant consideration while deciding an application for registration which was refused under Section 11 on the basis of such cited marks.

7.In response to these contentions, Mr. A.R.Sakthivel, learned Senior Panel Counsel (SPC), submitted that the application should be decided on the basis of marks which were registered on the date of hearing of the application for registration. By referring to the marks cited in the search report annexed to the examination report, learned counsel submitted that the mark "PACIFIC TELESIS INTERNATIONAL" was registered with effect from 07.04.1986 under Class 9. Similarly, he submitted that the label mark "PACIFIC" was registered under Trade Mark No.1299436 in Class 9 with effect from 29.07.2004. By contending that the prominent feature of these two marks is the word "PACIFIC", he submitted that these marks were used much prior to the adoption and use of the device mark of the appellant.

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Therefore, learned counsel submitted that the impugned order does not warrant interference. Learned counsel next contended that the rule of anti-dissection does not impose an embargo on the court or Registrar of Trade Marks from considering the prominent features of a mark. In support of this contention, he relied on the judgment of the Delhi High Court in *M/s.South India Beverages Pvt. Ltd. v. General Mills Marketing Inc.,* CDJ 2014 DHC 2287, particularly paragraph 20 thereof.

8.From the application of the appellant, it follows that the appellant sought registration of a device mark. The said device mark comprises about three elements. The first of the elements is two triangles, one of which is inverted. Besides these two triangles is the word “PACIFIC” and beneath the word “PACIFIC” are the words “POWER SOURCE”. This device mark was proposed to be used in relation to the specific goods, described earlier in this order. It should be noticed that the corporate name of the appellant is Pacific Power Source, Inc. and such corporate name appears to indicate the reason for adoption of the word elements of the device mark.

9.Turning to the search report and the examination report, multiple marks are cited therein. Out of the cited marks, only two marks were shown

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as registered as on the date of the search report. Learned SPC, therefore, relied heavily on the said marks to oppose the appeal. The first of these marks is Trade Mark No.452163 for "PACIFIC TELESIS INTERNATIONAL". This mark was registered with effect from 07.04.1986 in relation to telecommunication equipments, parts and fittings therefor. The additional documents produced by learned counsel for the appellant indicate that this mark was last renewed up to 07.04.1993. Even without taking the said development into consideration, it appears that telecommunication equipments are not similar to the goods in respect of which the appellant applied the device mark.

10.As regards the second mark on which learned SPC relied, it appears to be a label mark. The label mark was not renewed. By relying on the additional typed set, learned counsel for the appellant pointed out that this mark was last renewed up to 29.07.2014. Even otherwise, it appears that the mark was used in relation to : apparatus used for recording, transmission or reproduction of sound; life saving and teaching apparatus; nautical, surveying and checking equipments; and related goods. While the generic expression electrical goods is used, it does not appear that the cited mark was used in relation to goods which are identical or similar to the goods of

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the appellant.

11.While deciding an application for infringement, as correctly contended by learned SPC, the anti-dissection rule does place an embargo on the court examining the prominent features of the relevant marks. In the context of a hearing in relation to an application for registration, if the objection is under Section 11 (1) of the Trade Marks Act, the first question to be examined is whether identical or similar marks are being used in relation to identical or similar goods. If that hurdle is crossed, the next question would be whether there exists a likelihood of confusion on the part of the public, including by way of association with the earlier trade marks. Therefore, in the present context, the cited marks are relevant for the limited purpose of examining whether there would be any confusion on the part of the public, if goods bearing the mark for which registration has been applied for and goods bearing the cited marks are viewed by the public. By examining the device mark of the appellant and the cited marks and by taking into account the goods in respect of which the appellant's mark is used, I am of the view that there does not appear to be scope for confusion.

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12.The impugned order referred to Sections 9 and 11 of the Trade Marks Act and the grounds of decision referred to the prominent part of the appellant's mark being prominently present in the cited marks and that the cited marks are earlier in time.

13. For reasons set out above, these conclusions are not sustainable. Therefore, the impugned order is set aside. In the facts and circumstances, the application shall proceed to advertisement. By way of abundant caution and notwithstanding Section 17 of the Trade Marks Act, the appellant shall not claim exclusive right over the words “PACIFIC”, “POWER” or “SOURCE”, when used separately. It is also made clear that this order shall not be binding on opponents, if any.

14. On the above mentioned terms, (T)CMA(TM).No.134 of 2023 is allowed. There shall be no orders as to costs.

17.10.2023

Internet : Yes/No
Speaking/Non-Speaking Order
Neutral Citation : Yes/No

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To:

The Registrar of Trade Marks,
Trade Marks Registry,
Chennai.

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SENTHILKUMAR RAMAMOORTHY, J.

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